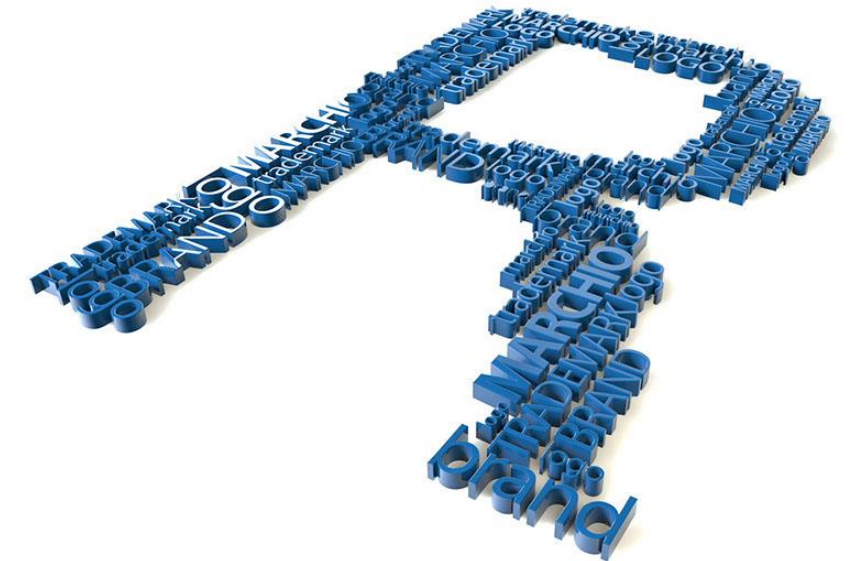


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Webinar LES ITALY - POLIMI New Italian PTO Trademark Invalidity and Revocation Proceedings *The IP Attorney's Point of View*

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July 10, 2023



New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

The context -- Article 45 DIRECTIVE (EU) 2015/2436 – Directive to approximate the laws of the Member States relating to trade marks

Article 45

Procedure for revocation or declaration of invalidity

1. Without prejudice to the right of the parties to appeal to the courts, Member States shall provide for **an efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark.**

 The objective is to harmonize the efficiency, consistency and timeliness of decisions on the validity of registered trademarks through the Member States of the European Union

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

Objectives for IP Portfolio Management

- 1. To optimize the efficiency, predictability and cost-effectiveness of cancellation procedures on a global scale, in a similar way as we manage trademark oppositions all over the world for client brand owners.**
- 2. To increase the expeditiousness of post-registration decisions in order to facilitate business decision-making on the maintenance of a TM portfolio and the commercialization of brands.**
- 3. To ensure a greater consistency of decisions in the application of legal principles and modes of assessment of the validity of trademark registrations.**

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

1. Optimizing the efficiency, predictability and cost-effectiveness of cancellation procedure

- IP Attorneys more typically work within the framework of an annual client budget for searching, filing, prosecution, maintenance, watching and enforcing trademarks both in their home country and internationally for local clients.
- These operations are generally the subject of medium to top-level decision-making in client organizations and are also subject to annual audit and cost-management analysis. **A more efficient and cost-effective cancellation procedure favours quicker decision-making and higher business predictability.**
- Most major IPO's have been competent for invalidity and revocation proceedings for decades (EUIPO, USTTAB, JPO, UKIPO, CNIPA), therefore the new IPTO/UIBM cancellation proceedings mean getting up to speed with the international standard, which sophisticated brand owners are accustomed to. A quicker administrative decision-making, in time with possible cancellation actions in other jurisdictions, also increases business predictability for global brands.

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

1. Optimizing the efficiency, predictability and cost-effectiveness of cancellation procedure

- Moreover, for small enterprises and individual business, the low costs and easy procedures of the administrative proceedings are important since they imply easier access to justice and ensuring a fair balance between the monopoly of IP rights and the principle of free competition in the market.
- The proceedings are available since January 2023 and can be managed electronically directly on the web-based services platform of the PTO in a user-friendly manner, by the trademark owner or its appointed representative, like for oppositions proceedings. Tutorials are made available to the public of the website of the Ministry of Enterprises and Made in Italy, see:
 - <https://uibm.mise.gov.it/index.php/it/marchi/procedura-di-nullita>
 - <https://uibm.mise.gov.it/index.php/it/marchi/procedura-di-decadenza>

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

1. Optimizing the efficiency, predictability and cost-effectiveness of cancellation procedure

- The new administrative procedures will surely increase the number of cancellation applications (both for revocation and invalidity) being filed against Italian trademarks and Italian portions of International Registrations..
- The new administrative procedures also have the advantage of providing a venue before a single authority on issues of revocation and invalidity in addition to the civil courts, both for Italian trademarks and Italian portions of International Registrations.

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

2. Expeditiousness of post-registration decisions in order to facilitate business decision-making on the maintenance of a TM portfolio and the commercialization of brands.

- Cancellation proceedings should be concluded within an average time of two years (save for the suspension of the proceedings) from the filing of the application for revocation or invalidity.
- In comparison, the UIBM's recent opposition decisions have been issued more or less within this timeframe: e.g. Opposition No. 652020000151027 (MITHRA / MITRA ROSA) filed on May 22, 2020, and decided on April 20, 2023; Opposition No. 652020000084661 (AdvanceCare / ADVANCED DENTAL CARE) filed on Sept. 9, 2020, and decided on January 11, 2023.
- This time frame is similar to the EUIPO's practice in an average inter partes proceeding with 2-3 rounds of submissions (save for suspensions).

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

2. Expeditiousness of post-registration decisions in order to facilitate business decision-making on the maintenance of a TM portfolio and the commercialization of brands.

- Since a majority Italian brand owners with global registration portfolios start with filing an Italian trademark application and later extend the protection of the trademark through the Madrid System, an efficient and expeditious administrative procedure as regards invalidity also **favours the proper functioning of the central-attack as regards International registrations.**

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

3. Ensuring a greater consistency of decisions in the application of legal principles and modes of assessment of the validity of trademark registrations.

- Within the scope of the harmonization of laws and practices concerning trademarks in the EU, on the assessment of proof of use (relevant in both revocation procedures and invalidity procedures based on relative grounds), administrative procedures are referenced in: CP8 JOINT COMMUNICATION OF OCTOBER 2020 ON THE COMMON PRACTICE OF INTELLECTUAL PROPERTY OFFICES OF MEMBERS OF THE EU INTELLECTUAL PROPERTY NETWORK, ON USE OF A TRADE MARK IN A FORM DIFFERING FROM THE ONE REGISTERED, page 3 of full text at

https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/who_we_are/common_communication/common_communication_cp8_en.pdf

New Italian PTO Trademark Invalidity and Revocation Proceedings - The IP Attorney's Point of View

3. Ensuring a greater consistency of decisions in the application of legal principles and modes of assessment of the validity of trademark registrations.

- The IPTO / UIBM has also acquired an established and solid practice in oppositions based on relative grounds, since their introduction in 2013, and has a decision-making methodology which is uniformly consistent with EU practice and also with authoritative Italian case law.
- On certain points, for example the assessment of proof of use of a trademark, the analysis made by the Office is often much more in-depth to that of the civil courts, which are usually more involved with procedural and infringement issues.



***GRAZIE PER L'ATTENZIONE THANK
YOUR FOR YOUR ATTENTION***

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